



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,498	10/07/2005	Michael Hartung	PAT-01141	2273

26922 7590 03/19/2009

BASF CORPORATION
Patent Department
1609 BIDDLE AVENUE
MAIN BUILDING
WYANDOTTE, MI 48192

EXAMINER

MAYEKAR, KISHOR

ART UNIT	PAPER NUMBER
----------	--------------

1795

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

03/19/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

MARJORIE.ELLIS@BASF.COM
cdavenport@cantorcolburn.com
Mgolota@CantorColburn.com

Office Action Summary	Application No. 10/552,498	Applicant(s) HARTUNG ET AL.	
	Examiner Kishor Mayekar	Art Unit 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/05 & 12/05</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

1. Claims 1 and 13 are objected to because of the following informalities:

In claim 1, the recitation "for receiving electrocoat material" needs to be amended as --for receiving the electrocoat material--, the recitation "emersing" is not an American language, and the phrase --and-- is needed between the steps of "rotating" and "transporting"; and

In claim 13, to the recitation "an emersing area". And the recitation "means of transporting ... rotating and immersing" needs to be in the format "means for" to invoke 35 USC 112, sixth paragraph.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1795

In claim 1, the recitations "**the** tank base (1.6) at **the** end" and "the immersing area" lack antecedent basis. The recitation "A method ... comprising ... which comprises" is confusing. The recitation "a directed tank flow" is confusing when comparing to its identical recitation tank flow (1.9)

In claim 13, the recitations "the electrocoat material", "the base (1.4)" and "**the** tank base (1.6) at **the** end" lack antecedent basis.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-10 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nonomura et al. in combination with Besinger et al. (US 6,372,107 B1), both references cited by Applicant. Nonomura's invention is directed a method and an apparatus for dipping a substrate into an electrodeposition coating. Nonomura discloses that the method comprises the supplying of the recited electrocoating tank, the immersing of the substrate, the transporting of the substrate and the recited drawing off, and that the apparatus comprises the recited electrocoating tank with overflow tank, circulation

Art Unit: 1795

pump, flood pipes, conveying device, immersing area and emerging area (Fig. 1), wherein a prevention of pigment sedimentation or uniformization of pigment dispersion and removal of air bubbles or heat and prevention of adhesion of extraneous substances are attained (p. 57). The difference between Nonomura and the above claims is the provision of rotating (or means for rotating) the substrates in the immersing and emerging areas. Besinger teaches in a process and apparatus for dipping a substrate in an electrocoating coating the limitation (Fig. 1), such that absent of air bubbles or sedimentation of particles are avoided (c. 2, l. 32-58). The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Nonomura's teachings as suggested by Besinger because this would result in further removal of air bubbles and prevention of the sedimentation of dirt.

6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nonomura '708 as modified by Besinger '107 as applied to claims 1-10 and 12-14 above, and further in view of Lauke (US 4,558,438), another reference cited by Applicant. The difference between the references as applied above and the instant claim is the provision of subjecting the drawn off electrocoat material to ultrafiltration. Lauke teaches in a process and apparatus for dipping a substrate in an electrocoating coating the limitation (Fig. 1). The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the references' teachings

Art Unit: 1795

as suggested by Lauke because this would result in cleaning and purifying of the draw off electrocoat material.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kishor Mayekar whose telephone number is (571) 272-1339. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kishor Mayekar/
Primary Examiner, Art Unit 1795